

REMARKS

In the November 6, 2008 Office Action, all of the claims 1-5 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the November 6, 2008 Office Action, Applicant has amended claim 1 as indicated above. Also, claims 2 and 5 have been cancelled by the current Amendment. Thus, claims 1, 3 and 4 are now pending, with claim 1 being the only independent claim. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Rejections - 35 U.S.C. § 103

In paragraphs 2-4 of the Office Action, claims 1-5 stand rejected under 35 U.S.C. §103(a) as follows:

Claims 1-4 are rejected as being unpatentable over Japanese Patent Publication No. 61-73001 (Ohta) in view of Japanese Patent Publication No. 59-041602 (Iwai), and

Claim 5 is rejected as being unpatentable over the Ohta and Iwai publications as applied to claim 1, in view of International Patent Publication No. 02/088529 (Nakano).

In response, Applicants have cancelled claims 2 and 5 and amended independent claim 1 as mentioned above. Specifically, independent claim 1 has been amended to include the limitations of claims 2 and 5, and to more clearly define the present invention over the prior art of record.

More specifically, independent claim 1 now requires, *inter alia*, a suction mechanism including a first path and a second path, the first path having one end communicating with an inlet port that is open to the expansion chamber and an other end, the second path having an arc shape that is curved around a shaft center of the drive shaft, with the second path being configured to cause the refrigerant to flow into the expansion chamber when the other end is

at a predetermined rotation angle range of the piston. Clearly this arrangement is *not* disclosed or suggested by the Ohta, Iwai and/or Nakano publications, whether taken singularly or in combination.

In the Ohta publication (primary reference), the so-called suction mechanism includes a single axially extending path 8 that is always in communication with the sucked fluid supply pipe. Thus, the Ohta publication (primary reference) lacks a second path having an arc shape that is curved around a shaft center of the drive shaft whatsoever, and lacks a first path having one end communicating with an inlet port that is open to the expansion chamber with the second path being configured to cause the refrigerant to flow into the expansion chamber when the other end is at a predetermined rotation angle range of the piston.

The Iwai and Nakano publications suffer from similar deficiencies. The Iwai publication is merely relied upon in the Office Action to allegedly disclose an outer chamber (a) being a compression chamber, and an inner chamber (B) being an expansion chamber. The Nakano publication is merely relied upon in the Office Action to allegedly disclose an a piston with a gap having a swing bushing 2A. However, neither the Iwai publication nor the Nakano publication disclose or suggest a second path having an arc shape that is curved around a shaft center of the drive shaft whatsoever, or a first path having one end communicating with an inlet port that is open to the expansion chamber with the second path being configured to cause the refrigerant to flow into the expansion chamber when the other end is at a predetermined rotation angle range of the piston. Thus, even if these references were somehow combined with the device of the Ohta publication, such a hypothetical combination would not include the unique arrangement now set forth in independent claim 1.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents to create Applicants' unique arrangement of a suction mechanism as now set forth in independent claim 1.

Based on the above amendments and arguments, withdrawal of the rejection(s) of independent claim 1 is respectfully requested.

Moreover, Applicant believes that dependent claims 3 and 4 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 3 and 4 are further allowable because they include additional limitations, which in combination with the features of independent claim 1, are not disclosed or suggested in the prior art. Accordingly, Applicant respectfully requests that the rejections of dependent claims 3 and 4 be withdrawn in view of the above comments and amendments.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1, 3 and 4 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,

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